

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 10/665,867
Filed : September 19, 2003
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REMARKS

Claims 4, 17-19 and 23 are pending in the subject application. Applicants have herein canceled claims 4, 18, 19 and 23 as withdrawn, without prejudice. Applicants have amended the title to more accurately describe the invention to which the claims are directed. Applicants maintain that this amendment raises no issue of new matter. Accordingly, upon entry of this Amendment, claim 17 will be pending.

The Claimed Invention

This invention provides an antibody immunoreactive with an epitope comprising a unique sequence of EN-RAGE.

Title Amendment

The Examiner requested amending the title of the application so that the title is more clearly indicative of the invention to which the claims are directed.

In response, applicants have amended the title accordingly.

Double Patenting Rejections

The Examiner provisionally rejected claim 17 as allegedly unpatentable under 35 U.S.C. §101 over claim 17 of copending U.S. Serial No. 10/990,310.

In response, but without conceding the correctness of the

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Examiner's rejection, applicants note that claim 17 of U.S. Serial No. 10/990,310 has been cancelled, rendering the rejection moot.

The Examiner further rejected claim 17 under the judicially created doctrine of obviousness-type double patenting over claims 53-57 of copending U.S. Serial No. 10/783,635. According to the Examiner, a timely filed terminal disclaimer in compliance with 37 C.F.R. §1.321(c) may be used to overcome a provisional rejection based on a nonstatutory double patenting ground.

In response, but without conceding the correctness of the Examiner's rejection, applicants note that claims 53-57 of U.S. Serial No. 10/783,635 have been cancelled, rendering the rejection moot.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 17 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out the subject matter which applicants regard as the invention.

Specifically, the Examiner alleges that the term "unique" is a relative term that renders claim 17 indefinite.

In response, applicants respectfully traverse.

Claim 17 provides an antibody immunoreactive with an epitope comprising a unique sequence of EN-RAGE. Applicants maintain that the term "unique", in the context of claim 17, would be clearly

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understood by one skilled in the art to mean that the claimed antibody is immunoreactive with an epitope comprising an amino acid sequence of EN-RAGE, wherein that amino acid sequence is unique to EN-RAGE. That is, the amino acid sequence "unique" to EN-RAGE is found within EN-RAGE but not in other proteins.

Applicants further note that it is not a requirement for patentability that all claim terms be explicitly defined in the specification. Hence, no explicit definition of "unique" in this context need be provided in the specification.

Finally, applicants' position is only underscored by the Examiner's failure to provide alternative meanings for the term "unique" which allegedly would confuse one skilled in the art when ascertaining the metes and bounds of claim 17.

Accordingly, applicants maintain that claim 17 satisfies the requirements of 35 U.S.C. §112, second paragraph.

Rejection under 35 U.S.C. §102(b)

The Examiner rejected claim 17 under 35 U.S.C. §102(b), as allegedly anticipated by Hitomi, et al. (European Patent Application No. EP07311166A2).

Specifically, the Examiner states that Hitomi et al. teach peptides and antibodies that comprise sequences that are 92% identical to applicants' SEQ. ID. NO:2, thus meeting the limitations of claim 17. Applicants understand the Examiner's assertion to be that Hitomi, et al. teach antibodies against a polypeptide having a

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sequence sharing 92% sequence identity with applicants' SEQ. ID. NO:2.

In response, applicants respectfully traverse.

In order for a claim to be anticipated by a cited reference, the reference must teach each and every element set forth in the rejected claim. Hitomi, et al. fail to do this.

Again, claim 17 provides an antibody immunoreactive with an epitope comprising a *unique* sequence of EN-RAGE. As discussed above, the antibody of claim 17 is immunoreactive to an epitope comprising an amino acid sequence of EN-RAGE, wherein the sequence is found within EN-RAGE but not in any other proteins.

Applicants note that Hitomi, et al. fail to teach each and every element of claim 17, i.e. an antibody immunoreactive with an epitope comprising a *unique* sequence of EN-RAGE. Hitomi, et al.'s teaching of an antibody against a polypeptide which, by the Examiner's own admission, is not identical to EN-RAGE does not constitute a teaching of applicants' antibody.

Accordingly, applicants maintain that claim 17 meets the requirements of 35 U.S.C. §102(b).

Summary

For the reasons set forth hereinabove, applicants maintain that the claim pending is in condition for allowance, and respectfully request allowance.

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If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

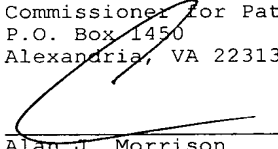
Respectfully submitted,



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1/12/06
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